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NOTICE OF ALLOWANCE AND FEE(S) DUE

26474

7590

04/28/2005

NOVAK DRUCE DELUCA & QUIGG, LLP 1300 EYE STREET NW SUITE 400 EAST WASHINGTON, DC 20005 EXAMINER

NAZARIO GONZALEZ, PORFIRIO

ART UNIT PAPER NUMBER

1621

DATE MAILED: 04/28/2005

ĺ	APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
	09/508 057	03/07/2000	CARSTEN BINGEL	0732-970223	4196

TITLE OF INVENTION: METHOD FOR PRODUCING METALLOCENES

APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PUBLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1400	\$0	\$1400	07/28/2005

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. PROSECUTION ON THE MERITS IS CLOSED. THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN THREE MONTHS FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. THIS STATUTORY PERIOD CANNOT BE EXTENDED. SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE REFLECTS A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE APPLIED IN THIS APPLICATION. THE PTOL-85B (OR AN EQUIVALENT) MUST BE RETURNED WITHIN THIS PERIOD EVEN IF NO FEE IS DUE OR THE APPLICATION WILL BE REGARDED AS ABANDONED.

HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL should be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). Even if the fee(s) have already been paid, Part B - Fee(s) Transmittal should be completed and returned. If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

IMPORTANT REMINDER: Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees when due.

PART B - FEE(S) TRANSMITTAL

Complete, and send this form, together w

pplicable fee(s), to: Mail

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INSTRUCTIONS: This form should be used for transmitting the ISSUE FEE and PUBLICATION FEE (if required). Blocks 1 through 5 should be completed where

appropriate. All further con indicated unless corrected be maintenance fee notification	selow or directed otherwise	Patent, advance order in Block 1, by (a) sp	rs and notification pecifying a new co	of maintenance fees prrespondence addres	s; and/or (b) indicating a sepa	correspondence address as a rate "FEE ADDRESS" for
CURRENT CORRESPONDENCE ADDRESS (Note: Use Block 1 for any change of address 26474 7590 04/28/2005 NOVAK DRUCE DELUCA & QUIGG, LLP 1300 EYE STREET NW SUITE 400 EAST WASHINGTON, DC 20005				Fee(s) Transmittal. T	of mailing can only be used for his certificate cannot be used	for any other accompanying
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				I hereby certify that States Postal Service addressed to the M	Certificate of Mailing or Transmission that this Fee(s) Transmittal is being deposited with the Unite rvice with sufficient postage for first class mail in an envelop e Mail Stop ISSUE FEE address above, or being facsimil te USPTO (703) 746-4000, on the date indicated below.	
WASHINGTON, I	JC 20003					(Depositor's name)
						(Signature)
						(Date)
APPLICATION NO.	FILING DATE	FIR	ST NAMED INVEN	TOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/508,057	03/07/2000		CARSTEN BINGE	L	0732-970223	4196
TITLE OF INVENTION: M	ETHOD FOR PRODUCING					
APPLN. TYPE	SMALL ENTITY	ISSUE FEE	PU	BLICATION FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1400		\$0	\$1400	07/28/2005
EXAM	IINER	ART UNIT	CI	ASS-SUBCLASS]	
NAZARIO GONZ	ALEZ, PORFIRIO	1621	556-011000			
 Change of correspondence address or indication of "Fee Address" (37 CFR 1.363). Change of correspondence address (or Change of Correspondence Address form PTO/SB/122) attached. "Fee Address" indication (or "Fee Address" Indication form PTO/SB/47; Rev 03-02 or more recent) attached. Use of a Customer Number is required. 			(2) the name of a single min (naving as a member a			
PLEASE NOTE: Unless	1 37 CFR 3.11. Completion	elow, no assignee dat of this form is NOT a	ta will appear on t substitute for filing	he patent. If an assi	gnee is identified below, the o	document has been filed for
Please check the appropriate	e assignee category or catego	ries (will not be printe	ed on the patent):	☐ Individual ☐	Corporation or other private gr	oup entity Government
4a. The following fee(s) are	enclosed:		ayment of Fee(s):			
Issue Fee			A check in the amount of the fee(s) is enclosed. Payment by credit card. Form PTO-2038 is attached.			
Publication Fee (No small entity discount permitted) Advance Order - # of Copies			The Director is hereby authorized by charge the required fee(s), or credit any overpayment, to Deposit Account Number (enclose an extra copy of this form).			
_ ' '	(from status indicated above		<u> </u>			
	MALL ENTITY status. See			_	ALL ENTITY status. See 37 C	
NOTE: The Issue Fee and P interest as shown by the reco	is requested to apply the Issue to States Patients of the United States Patients	will not be accepted freetrand Trademark Of	n Fee (if any) or to rom anyone other the ffice.	re-apply any previous and the applicant; a re	asly paid issue fee to the applic egistered attorney or agent; or t	the assignee or other party in
Authorized Signature			Date			
Typed or printed name			Registration No.			
This collection of informati an application. Confidential submitting the completed a this form and/or suggestion. Box 1450, Alexandria, Virg Alexandria, Virginia 22313	on is required by 37 CFR 1.3 ity is governed by 35 U.S.C pplication form to the USPT string this burden, slinia 22313-1450. DO NOT 1450.	11. The information i . 122 and 37 CFR 1.1 O. Time will vary de hould be sent to the C SEND FEES OR CO	is required to obtain 4. This collection pending upon the hief Information C MPLETED FORM	or retain a benefit b is estimated to take 1 individual case. Any officer, U.S. Patent at IS TO THIS ADDRE	y the public which is to file (an 2 minutes to complete, includi comments on the amount of ti d Trademark Office, U.S. Dep SS. SEND TO: Commissioner	d by the USPTO to process) ng gathering, preparing, and time you require to complete partment of Commerce, P.O. for Patents, P.O. Box 1450,

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09/508,057	03/07/2000	CARSTEN BINGEL 0732-970223		4196	
26474	7590 04/28/2005		EXAM	EXAMINER	
	CE DELUCA & QUIC	NAZARIO GONZALEZ, PORFIRIO			
1300 EYE STREET NW SUITE 400 EAST			ART UNIT	PAPER NUMBER	
WASHINGTON	, DC 20005		1621		
			DATE MAILED: 04/28/2004	ς .	

Determination of Patent Term Extension under 35 U.S.C. 154 (b)

(application filed after June 7, 1995 but prior to May 29, 2000)

The Patent Term Extension is 418 day(s). Any patent to issue from the above-identified application will include an indication of the 418 day extension on the front page.

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Extension is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (http://pair.uspto.gov).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571) 272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at (703) 305-8283.

-	Application No.	Applicant(s)
•		
Notice of Allowability	09/508,057	BINGEL ET AL.
Nouce of Anowability	Examiner	Art Unit
	Porfirio Nazario-Gonzalez	1621
The MAILING DATE of this communication apperature All claims being allowable, PROSECUTION ON THE MERITS IS herewith (or previously mailed), a Notice of Allowance (PTOL-85) NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT R of the Office or upon petition by the applicant. See 37 CFR 1.313	(OR REMAINS) CLOSED in this ap or other appropriate communicatio IGHTS. This application is subject	oplication. If not included n will be mailed in due course. THIS
1. \boxtimes This communication is responsive to <u>decisions by the BPA</u>	I and US Court of Appeals.	
2. The allowed claim(s) is/are 2 and 4-12.		
3. The drawings filed on are accepted by the Examine	r.	
 4. Acknowledgment is made of a claim for foreign priority una) All b) Some* c) None of the: 1. Certified copies of the priority documents have 2. Certified copies of the priority documents have 3. Copies of the certified copies of the priority do International Bureau (PCT Rule 17.2(a)). * Certified copies not received: 	e been received. e been received in Application No.	
Applicant has THREE MONTHS FROM THE "MAILING DATE" noted below. Failure to timely comply will result in ABANDONN THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.		complying with the requirements
5. A SUBSTITUTE OATH OR DECLARATION must be subminformal PATENT APPLICATION (PTO-152) which give		
 CORRECTED DRAWINGS (as "replacement sheets") must (a) including changes required by the Notice of Draftspers 1) hereto or 2) to Paper No./Mail Date (b) including changes required by the attached Examiner' Paper No./Mail Date Identifying indicia such as the application number (see 37 CFR 1 each sheet. Replacement sheet(s) should be labeled as such in the sheet. Replacement sheet(s) should be labeled as such in the deposit of the sheet of the sheet. DEPOSIT OF and/or INFORMATION about the deposit of the sheet. 	son's Patent Drawing Review (PTO . s Amendment / Comment or in the .84(c)) should be written on the draw he header according to 37 CFR 1.121 sit of BIOLOGICAL MATERIAL	Office action of ings in the front (not the back) of (d). must be submitted. Note the
Attachment(s) 1. Notice of References Cited (PTO-892) 2. Notice of Draftperson's Patent Drawing Review (PTO-948) 3. Information Disclosure Statements (PTO-1449 or PTO/SB/O Paper No./Mail Date	5. Notice of Informal 6. Interview Summan Paper No./Mail Da 08), 7. Examiner's Amend	Patent Application (PTO-152) y (PTO-413), ate

Application/Control Number: 09/508,057

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REASONS FOR ALLOWANCE

1. The following is an examiner's statement of reasons for allowance:

After review of Paper No. 53 (Sullivan Preliminary Motion 2) and Paper No. 66 (Sullivan Revised Preliminary Motion 1) as recommended by the Board of Patent Appeals and Interferences in their Final Judgment and Recommendation for Interference No. 104,818 (Paper No. 14), the Examiner finds the claims allowable over the prior art cited.

In Paper No. 66, it is alleged that instant claims are obvious over EP 0 416 815 in view of Eisch et al., Organometallic Synthesis, Volume 1, page 76, Academic Press, N.Y. (1965). It is particularly noted, as a motivation to combine the reference, the footnote 54, which states "1,2-dimethoxyethane is more resistant than tetrahydrofuran to cleavage by the rather reactive metal tetrahalides". The footnote is in reference to the synthesis of sodium cyclopentadienide (NaC₃H₅) in which 1,2-dimethoxyethane (DME) was used as a solvent. See lines 5-8 of page 76. It is clear that the intent or motivation of replacing tetrahydrofuran (THF) with 1,2-dimethoxyethane (DME) as a solvent was primarily for the synthesis of sodium cyclopentadienide (NaC₅H₅) and not for the formation of the metal halide adduct MCl₄DME. As a matter of fact, the reference does not mentions the formation of an adduct when the metal halide was added. The key feature in the claimed process is the use of the metal halide adduct, not the use of DME as a solvent. Thus, the motivation to substitute the MCl₃(THF)₃ or MCl₄(THF)₂ adducts in the '815 EP patent with MCl₄DME is not in the Eisch et al. reference.

Paper No. 53 is a motion for judgment against claims 2 and 4-12 on the ground that each claim is barred by claim 4 of U.S. Patent No. 6,015,916 under 35 U.S.C. § 135(b). At issue is whether the copied claims recite the same or substantially the same subject matter as the subject

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matter patented in claim 4 in the U.S. Patent No. 6,015,916. The answer is no. Claim 4 of the '916 patent is directed to a process of making a constrained geometry titanium(II) diene complex of the formula III. In contrast, the instant claims are directed to a constrained geometry Group 4 metal dichloride complex. The motion also argues that unamended claims 8-12 (copied claims) are not the same or substantially the same as original claims 1-3. Particularly, the motion points out that the step (i) of '916 claim 10 and the limitation "n is 4" are not included in the original claims 1-3. The scope of the '916 claim 10 is narrowed to the original instant claims 1-3. However, the phrase "A process for preparing a metallocene, which comprises reacting a ligand starting compound..." clearly reads on the alkali metal salt of the compound of Formula I (as recited in claim 8). Note that the final product is a metallocene and therefore it narrows the "ligand starting compound" to be a cyclopentadiene-type ligand as shown in the formula I in claim 8. Secondly, the scope of the formula M¹X_nD_a embraces the formula TiCl₄.DME. Particularly when M is a Group IV metal, n is 4 and D is a polyether. Thus, the subject matter of claims 2 and 4-12 is substantially the same as the subject matter of original claims 1-3 and therefore entitled to the earlier effective filing date of claims 1-3 for the purposes of satisfying 35 U.S.C § 135 (b).

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Porfirio Nazario-Gonzalez whose telephone number is 571-272-0641. The examiner can normally be reached on Mon.-Fri. (9:30 AM - 6:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pomirio Nazario-Ganzale Primary Parent Examiner

PNG April 26, 2005